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Serial No. 10/037,683  
Response to Office Action  
Mailed October 19, 2006REMARKS

In the Office Action, the Examiner rejected claims 29-48. Currently, claims 29-48 are pending in the present application and are believed to be in condition for allowance. In view of the and following remarks, Applicants respectfully request allowance of all pending claims.

Rejection Under 35 U.S.C. § 103

In the Office Action, the Examiner rejected claims 29-33, 35-44 and 46-47 as obvious over Pettersen (U.S. Patent No. 6,826,594, hereinafter "the Pettersen reference") in view of Chen et al. (U.S. Patent No. 6,021,437, hereinafter "the Chen reference"), claim 34 as obvious over Pettersen in view of Chen and Thurston (U.S. Patent No. 6,865,716), claim 45 as obvious over Pettersen in view of Chen and Lynch et al. (U.S. Patent No. 6,823,319, hereinafter "the Lynch reference"), and claim 48 as obvious over Pettersen in view of Chen and Ellison et al. (U.S. Patent No. 6,487,547, hereinafter "the Ellison reference"). Applicants respectfully traverse these rejections.

Legal Precedent

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227

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U.S.P.Q. 972 (B.P.A.I. 1985). The Examiner must provide objective evidence, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). Moreover, a statement that the proposed modification would have been “well within the ordinary skill of the art” based on individual knowledge of the claimed elements cannot be relied upon to establish a *prima facie* case of obviousness without some *objective reason to combine* the teachings of the references. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993); *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d. 1313, 1318 (Fed. Cir. 2000); *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 U.S.P.Q.2d. 1161 (Fed. Cir. 1999).

Further, the pending claims must be given an interpretation that is reasonable and consistent with the *specification*. See *In re Prater*, 415 F.2d 1393, 1404-05, 162 U.S.P.Q. 541, 550-51 (C.C.P.A. 1969) (emphasis added); M.P.E.P. §§ 608.01(o) and 2111. Indeed, the specification is “the primary basis for construing the claims.” See *Phillips v. AWH Corp.*, No. 03-1269, -1286, at 13-16 (Fed. Cir. July 12, 2005) (*en banc*). One should rely *heavily* on the written description for guidance as to the meaning of the claims. See *id.*

Interpretation of the claims must also be consistent with the interpretation that *one of ordinary skill in the art* would reach. See *In re Cortright*, 165 F.3d 1353, 1359, 49 U.S.P.Q.2d 1464, 1468 (Fed. Cir. 1999); M.P.E.P. § 2111. “The inquiry into how a person of ordinary skill in the art understands a claim term provides an objective baseline from which to begin claim interpretation.” See *Collegenet, Inc. v. ApplyYourself, Inc.*, No. 04-1202, -1222, 1251, at 8-9 (Fed. Cir. August 2, 2005) (quoting *Phillips*, No. 03-1269, -1286, at 16). The Federal Circuit has made clear that derivation of a claim term must be based on “usage in the ordinary and accustomed meaning of the words amongst artisans of ordinary skill in the relevant art.” See *id.*

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Additionally, it is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983); M.P.E.P. § 2145. Moreover, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (CCPA 1959); see M.P.E.P. § 2143.01(VI). If the proposed modification or combination would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); see M.P.E.P. § 2143.01(V).

#### **First Rejection**

In the Office Action, the Examiner rejected claims 29-33, 35-44 and 46-47 as obvious over the Pettersen reference in view of the Chen reference. Applicants respectfully traverse this rejection.

#### ***Claim 29***

The Examiner's rejection is flawed for a number of reasons. In claim 29, the same server both serves a web page and receives a request for an object file. Specifically, claim 29 recites "serving a web page to a requesting computer from a managed server," and "receiving a request from the requesting computer to the managed server for the object file." (Emphasis added.) As explained below, the cited references do not teach or suggest, alone or in hypothetical combination, a managed server that both serves a web page comprising a source call to an object file and receives a request for the object file.

In sharp contrast to claim 29, the Pettersen reference teaches a remote content management system in which a web site and advertisements to be inserted into the web site are requested from different servers. See Pettersen, col. 6, ll. 8-21, and Fig. 11. Specifically, the Petterson reference teaches serving a website with the following steps:

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- 1) an affiliate web server 791 serves a web page 793 to a user system 760 (Pettersen, Fig. 11 and column 6, lines 39-41);
- 2) the user system 760 then requests advertisements from a web server 781 for a content serving website 780 (Pettersen, Fig. 11 and column 7, lines 13-16); and
- 3) the user system 760 then inserts the advertisements into the web page 793 (Pettersen, Fig. 11 and column 7, lines 34-37).

Significantly, the affiliate web server 791 is not the same server as the web server 781, so the request to the web server 781 for advertisements is not a request to the affiliate web server 791. In other words, the user system 760 does not request the advertisements from the server 791 that provides the web site. *See id* at col. 7, ll. 5-15. That is, different servers provide the web site and the inserted advertisement data. Thus, the Pettersen reference does not teach or suggest a managed server that both serves a web page comprising a source call to an object file and receives a request for the object file.

The Chen reference does not teach or suggest this feature, either. Indeed, the Chen reference does not even teach an object file, let alone a managed server that receives a request for an object file. The Chen reference teaches intelligent agents that fully construct a web page on a server before serving the web page to a client. *See* Chen, col. 3, ll. 31-32. Thus, because the web page is received by the client in its entirety, these web pages do not prompt a client computer to request additional data, such as an object file, after receipt of the web pages. Thus, the Chen reference does not teach receiving a request to a managed server for an object file.

In view of these deficiencies, among others, the Pettersen reference and the Chen reference, taken alone or in hypothetical combination, cannot render obvious claim 29 or the claims that depend therefrom.

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***Claim 37***

The Examiner's rejection of claim 37 is also flawed. The cited references do not teach or suggest, alone or in hypothetical combination, "requesting data corresponding to the first embedded object from the managed server after receiving the frame from the managed server," as recited by independent claim 37. (Emphasis added.) That is, in claim 37, data corresponding to the first embedded object is requested from the same server that provided the frame. In contrast, as discussed above, the Pettersen reference teaches a remote content management system in which a web site and advertisements to be inserted into the web site are requested from different servers. See Pettersen, col. 6, ll. 8-21, and Fig. 11. Thus, even if, *ad arguendo*, the web server 791 for the affiliate site 190 is a managed server, the advertisements are provided by another web server 781 associated with the advertisements, and any requests for the advertisements are not from the server 791 that provides the web site. See *id* at col. 7, ll. 5-15. Further, as noted above, the Chen reference teaches web pages that are received by the client in their entirety. In other words, these web pages do not prompt a client computer to request additional data from the server providing the web pages, so Chen does not teach requesting data corresponding to an embedded object from any server, let alone from a server that previously provided a frame. Thus, the cited references, taken alone or in hypothetical combination, do not teach or suggest all the steps of independent claim 37.

Previously, the Applicants alerted the Examiner to this inadequacy in the Request for Continued Examination (RCE) filed on August 2, 2006. See RCE, page 6. In the Office Action mailed October 19, 2006, the Examiner did not address this inadequacy with any specificity. Instead, the Examiner merely remarked that "The Examiner respectfully disagrees with the Applicant and believes the above rejection clearly teaches each limitation of the independent claim." Office Action, page 11. However, the portion of the rejection referred to by the Examiner, i.e., Office Action, page 5, merely indicates that advertisements are inserted into a web page, not that the web page and advertisements are requested from the same source. Thus, the Examiner did not address

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all of the Applicants' arguments. If the Examiner maintains this rejection, the Applicants respectfully request that the Examiner identify portions of Chen or Petterson that teach these features.

***Claim 46***

Independent claim 46 recites a "first embedded object [that] is executable on a client remote from the server to request the dynamic data." (Emphasis added.) In contrast, the Petterson reference teaches retrieving static, pre-stored advertisements and inserting the static advertisements in a web page dynamically. *See e.g.*, Petterson, col. 7, ll. 11-13; col. 8, ll. 37-42; and col. 10, ll. 35-46. The advertisements are stored in a smart zone content database 785 (*Id.* at col. 7, ll. 11-13) and are dynamically inserted into a web page (*See id.* at col. 7, ll. 6-8) when the web page is displayed. However, the advertisements do not change, i.e., the advertisement data is static. *See id.* at col. 7, ll. 52-59. Indeed, the only disclosed method of changing the advertisements in the database 785 is manually editing the list of advertisements. *See id.* Thus, the Petterson reference does not teach or suggest an embedded object that is executable to request dynamic data. Further, as noted above, both the Chen reference and the Thurston reference teach web pages that do not prompt a client computer to request additional data. Therefore, because these web pages do not request additional data, they clearly do not include embedded objects that are executable on a client to request dynamic data. Accordingly, the cited references, taken alone or in hypothetical combination, do not teach or suggest all of the features recited by independent claim 46.

In the Office Action, the Examiner attempted to address this inadequacy, remarking that "even if the Examiner was to agree with the argument in regards to Petterson, the Chen et al[.] reference clearly teaches a benefit of requesting and providing real-time dynamic data to be embedded into a web page." Office action, page 11.

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However, the Examiner still has not addressed Applicants' argument. Neither reference teaches an "embedded object [that] is executable on a client remote from the server to request the dynamic data." (Emphasis added.) Even if, *ad arguendo*, the Chen reference teaches "a benefit of requesting and providing real-time dynamic data to be embedded into a web page," this does not mean that the Chen reference teaches an embedded object that is executed on a client to provide such a benefit. Indeed, as explained above, the Chen reference does not teach any embedded object. Thus, regardless of the benefit identified by the Examiner, the Chen reference does not teach or suggest this feature, and the present rejection remains flawed.

***Improper Combination - Lack of Objective Evidence of Reasons to Modify/Combine***

In addition, the Examiner has not shown the requisite motivation or suggestion to modify or combine the cited references to reach the present claims. The Examiner must provide objective evidence, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). In the present rejection, the Examiner combined the Pettersen and Chen references based on the *conclusory and subjective statement* that it would have been obvious "for the dynamic data of Pettersen to have been created in real-time as disclosed in Chen et al, because Chen et al teach said process provides a simple, effective, and inexpensive to implement way for real-time monitoring of data column 2, lines 31-38)." Final Office Action Mailed on May 19, 2006, page 3. However, this is merely the speculative opinion of the Examiner that is inconsistent with Chen, who already teaches a technique for constructing a web page with the server data, and Examiner has not provided any evidence to indicate why one of ordinary skill in the art would find the technique taught by Chen inadequate and replace it with the process for forming a web page taught by Pettersen. Accordingly, Applicants respectfully request the Examiner to produce *objective evidence* of the requisite motivation or suggestion to combine the cited references, or remove the foregoing rejection under 35 U.S.C. § 103.

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In the Office Action, the Examiner attempted to address this deficiency, remarking:

Petterson teaches a method for delivering dynamic content from a server to a client browser after a web page has been provided to the client browser. The Petterson reference also teaches wherein the dynamic content was generated at runtime. The Petterson reference however does not specifically teach wherein the data was indicative of a real-time current status of a managed server. Chen et al. cures this deficiency by teaching creating dynamic data indicative of the status of a managed server generated in real-time and delivering said dynamic data to a client browser (Abstract; column 2, lines 31-67, column 4, lines 10-19). Chen et al. also teach that creating dynamic data in real-time provides the benefit of a simple, effective, and inexpensive way to implement real-time monitoring of data (column 2, lines 31-38). Thus Chen et al. provides the Petterson reference the ability for a user to provide administration and maintenance support of a data processing system.

Office Action, page 12.

However, the Examiner still has not provided a valid reason to combine Chen with Pettersen. One of skill in the art would not combine these references unless the combination provided a benefit that neither reference provided in isolation. That is, the combination must have some utility over each reference; otherwise, there would have been no reason to combine them. For example, if Chen's system accomplishes a given task, there would have been no reason to combine Chen with Pettersen to accomplish the same task. Here, the Examiner speculates that an artisan would combine Chen with Pettersen because the combination would offer "real-time monitoring of data" and "the ability for a user to provide administration and maintenance support of a data processing system." However, the system taught by Chen already offered these benefits. Thus, an artisan would simply have implemented the system taught by Chen to achieve "real-time monitoring of data" and "the ability for a user to provide administration and maintenance support of a data processing system" without having had any motivation to turn to the



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Petterson reference. Accordingly, if the Examiner maintains this rejection, the Applicants respectfully request that the Examiner provide objective evidence of why one of ordinary skill in the art would have been motivated to combine these references.

***The References Teach Away from the Proposed Combination***

As summarized above, it is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983); M.P.E.P. § 2145. Here, the Petterson reference teaches away from acquiring data in the manner taught by the Chen reference.

As discussed above, the Pettersen reference teaches a remote content management system in which a web site and advertisements to be inserted into the web site are requested from different servers. *See* Pettersen, col. 6, ll. 8-21, and Fig. 11. The primary web page 791 comes from the affiliate web server 791, and the inserted advertisement data comes from the server 781 for a content serving website 780. *Supra*. To explain the utility of such a system, the Petterson reference emphasizes both the importance of storing the advertisement data on a remote server and the problems associated with placing the advertisement data on the affiliate's web server. *See* Pettersen, col. 2, ll. 32-40. That is, the Petterson reference teaches away from acquiring the primary web page and the data inserted into the web page from the same server.

In contrast, Chen teaches precisely the arrangement of web servers and inserted data that the Pettersen system is designed to avoid. In Chen, the real-time server data comes from the same server that provides the primary web page in which the real-time server data is inserted. As explained above, the Chen reference teaches web pages that are received by the client in their entirety, so Chen teaches acquiring the web page and the inserted data from the same server.

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Thus, the proposed modification is improper because the references teach away from one another. The Petterson reference teaches that frequently changing data that is inserted into a web page should not be acquired from the same server as the web page, and the Chen reference teaches acquiring the real-time server data from the same server that provides the web page in which the data is inserted.

### **Second Rejection**

In the Office Action, the Examiner rejected claim 34 as obvious over the Pettersen reference in view of the Chen reference and the Thurston reference. Applicants respectfully traverse this rejection.

The rejection of claim 34, which depends from claim 29, is defective for at least the reasons set forth above with respect to the rejection of claim 29 under Section 103. Specifically, neither the Chen reference nor the Pettersen reference, alone or in hypothetical combination, teach or suggest a managed server that both serves a web page comprising a source call to an object file and receives a request for the object file, as recited by parent claim 29, and the Thurston reference does not cure this deficiency. Accordingly, the Pettersen reference, the Chen reference and the Thurston reference, taken alone or in hypothetical combination, cannot render claim 34 obvious.

### **Third Rejection**

In the Office Action, the Examiner rejected claim 45 as obvious over the Pettersen reference in view of the Chen reference and the Lynch reference. Applicants respectfully traverse this rejection.

The rejection of claim 45, which depends from claim 37, is defective for at least the reasons set forth above with respect to the rejection of claim 37 under Section 103. Specifically, neither the Chen reference nor the Pettersen reference, alone or in hypothetical combination, teach or suggest "requesting data corresponding to the first

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embedded object from the managed server after receiving the frame from the managed server,” as recited by parent claim 37 (emphasis added), and the Lynch reference does not cure this deficiency. Accordingly, the Pettersen reference, the Chen reference and the Lynch reference, taken alone or in hypothetical combination, cannot render claim 45 obvious.

#### **Fourth Rejection**

In the Office Action, the Examiner rejected claim 48 as obvious over the Pettersen reference in view of the Chen reference and the Ellison reference. Applicants respectfully traverse this rejection.

The rejection of claim 48, which depends from claim 46, is defective for at least the reasons set forth above with respect to the rejection of claim 46 under Section 103. Specifically, neither the Chen reference nor the Pettersen reference, alone or in hypothetical combination, teach or suggest a “first embedded object [that] is executable on a client remote from the server to request the dynamic data,” as recited by parent claim 46 (emphasis added), and the Ellison reference does not cure this deficiency. Accordingly, the Pettersen reference, the Chen reference and the Ellison reference, taken alone or in hypothetical combination, cannot render claim 48 obvious.

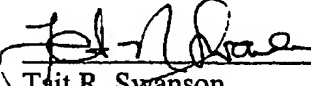
For these reasons among others, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 103.

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Applicants respectfully submit that all pending claims should be in condition for allowance. However, if the Examiner believes certain amendments are necessary to clarify the present claims or if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

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